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CHARLES ELMORE SHEPLEY

IN THE
Supreme Court of the United States

OCTOBER TERM, 1947.

GILBERT E. R. HANSON and JOSEPH SCHWARTZ, Individually and as Co-Partners, Doing Business as "SEVENTEEN For The Junior Teens," and Doing Business as "SEVENTEEN JUNIORIZED TEENS," and Doing Business as "DICK HANSON COMPANY,"

Petitioners,

v.

TRIANGLE PUBLICATIONS, INC.

Respondent.

ON PETITION FOR WRIT FOR CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE EIGHTH CIRCUIT.

BRIEF IN OPPOSITION.

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*Gilbert E. R. Hanson and Joseph Schwartz, Individually
and as Co-Partners, Doing Business as "SEVENTEEN
for the Junior Teens" and Doing Business as
"SEVENTEEN . . . JUNIORIZED TEENS," and Doing
Business as "DICK HANSON COMPANY,"*

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ON PETITION FOR WRIT FOR CERTIORARI TO THE UNITED
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BRIEF IN OPPOSITION.

STATEMENT OF THE CASE.

An injunction was granted in this case by the District
Court, and sustained by the Circuit Court of Appeals, to

restrain defendants' deliberate appropriation and exploitation of the trade mark of plaintiff's teen-age fashion magazine for the sale of defendants' teen-age dresses.

The trial judge found that plaintiff's magazine, "SEVENTEEN", attained nationwide preeminence in the field of teen-age fashions almost immediately upon its first appearance, as a result of various factors, including its high quality and an intensive and expensive pre-publication promotion campaign. Defendants soon thereafter copied the name for their dresses in the same teen-age fashion field, and the court found that this was done with full knowledge of the success and fame of plaintiff's magazine and with the specific intent to capitalize upon it. The court's conclusion was (R. 947):

"Paraphrasing the statement of a distinguished jurist, one cannot escape the conclusion that the defendants were overcome by the sight of a well built, gassed, oiled and chauffeured vehicle ready to go, and could not refrain from attempting a free commercial ride upon it."

The defense consists principally in the contention that since plaintiff's product is a magazine and defendants' goods are dresses, defendants cannot be restrained from misappropriating the name.

"SEVENTEEN" magazine first appeared on September 1, 1944. A nationwide promotion campaign had been commenced a month in advance of publication, to acquaint the public, the fashion trade and girls' organizations with the magazine's aim. Plaintiff spent more than \$35,000 in August, 1944, and by December 31, 1944, had spent more than \$150,000 in publicizing and promoting "SEVENTEEN" (R. 954).

The magazine was an immediate and tremendous success. The first issue sold more than 380,000 copies, and circulation steadily increased thereafter, exceeding 600,000

by January, 1945 (R. 954-955). Thereafter it went to 750,000, and is now over 1,000,000. The size of each issue increased from the original issue of 86 pages, including 46 of advertising, to 156 pages, with 101 of advertising, by November, 1945 (R. 955). Advertising rates, originally \$750 per page, were increased to \$1200 per page on May 1, 1945, and to \$1800 on January 1, 1946 (R. 276-277).

The immediate success of the magazine was widely recognized. In the April 15, 1945 issue of "TIDE", the national advertising periodical, "SEVENTEEN" was referred to as a more outstanding success in its field than "Oklahoma" in the theatrical field (R. 417). Seven officials of the most prominent merchandising concerns, and even one of defendants' own witnesses, testified that "SEVENTEEN" became immediately the outstanding magazine in its field (R. 393-400, 470, 498, 499).

In the first four months of its publication "SEVENTEEN" received more than a hundred requests from manufacturers and merchandisers for permission to use its name, which were refused (R. 70-79), and in the same period other manufacturers began, without permission, to make and sell various articles of teen-age apparel under the name "SEVENTEEN" (R. 67-68). Substantially all of these discontinued their use immediately upon request. Defendant, however, refused to do so. Department stores throughout the country immediately started "tying in" "SEVENTEEN" with advertisements and displays of teen-age apparel, a practice which, in the case of apparel actually advertised, or editorially commented upon in the magazine, is sanctioned and encouraged by plaintiff (R. 158-163).

"SEVENTEEN", as is the case with every successful fashion magazine, plays an integral part in the process of merchandising teen-age apparel, beginning with the manufacturing phase and carrying through to the actual merchandising to the ultimate purchaser, and this role of

fashion magazines is well known to merchants and the buying public (R. 955).

The magazine's fashion editors exchange information and ideas on fashions with the principal manufacturers of apparel, and select and suggest apparel which will be suitable in style, price and taste for teen-age girls.

"SEVENTEEN" sells to manufacturers reprints, counter cards and blow-ups of editorial comments on, and advertisements of, their apparel appearing in the magazine. It also sells them hang tags containing the words "You saw it in SEVENTEEN", to be used on dresses featured in the magazine. This material is used by the manufacturers in their own displays to attract merchandisers, and is also forwarded to merchandisers for use in store displays of the apparel (R. 955-956).

The magazine advises merchandisers in the preparation and arrangement of window displays and department displays of apparel featured in the magazine. These displays have a background of reprints from "SEVENTEEN", including reproductions of the cover, and other material emphasizing the connection between the apparel and the magazine (R. 956).

The magazine also advises merchandisers how to arrange and present fashion shows featuring apparel advertised or editorially commented on in "SEVENTEEN", and in these shows the connection between the apparel and the magazine is emphasized in order to heighten consumer interest in the apparel (R. 956). A part of the same process of using "SEVENTEEN" in the merchandising of apparel is the widespread tying-in of "SEVENTEEN" in newspaper advertisements of apparel previously advertised or commended upon in the magazine, which we have already mentioned. In one typical month, February, 1945, 750 stores in 521 cities ran newspaper advertisements tying in teen-age apparel with "SEVENTEEN" magazine (R. 956).

In the pages of the magazine itself, at least 60% of each issue is devoted to fashion comment and advertising.

The magazine advises high school girls as to what clothes are appropriate for them, and how to make the most of themselves, and inappropriate advertising is not accepted. It runs a monthly dress pattern page which sells an average of over 3,000 patterns per month (R. 957).

These activities have been described at some length because an understanding of the active role of fashion magazines such as "SEVENTEEN" in the complex merchandising processes of the fashion industry is essential to an understanding both of the economic importance of granting effective protection against the misappropriation of good will by adventurers in this field, and of the ease with which confusion of the public may be created in such a field unless effective protection is granted. In this case it was shown that of 382 answers received to a questionnaire sent out by "SEVENTEEN" to 1,000 subscribers selected at random, four out of five believed that a dress sold under defendants' trade name, "SEVENTEEN for the Junior Teens", would be either sponsored by, or in some way connected with, "SEVENTEEN" magazine (R. 177-179). This same conclusion was confirmed by the testimony of the manufacturing and merchandising officials (R. 393-400).

The District Court found as a fact, upon the basis of overwhelming evidence, that defendants had deliberately chosen the word "Seventeen" as part of the trade name for their dresses, with full knowledge of the reputation which the magazine had at that time acquired by virtue of the instant favor which it had won among high school girls, and with the specific object of thereby appealing to the group reached by the magazine (R. 958).

The evidence completely supported this finding. Defendant Hanson's own testimony as to the circumstances under which the name was appropriated was, to say the least, incredible, nor was the demeanor of this witness on the stand such as to inspire in the trial judge confidence in his veracity. The Circuit Court of Appeals was similarly impressed with his testimony (R. 1022). The other defendant, Schwartz, never even took the witness stand.

Hanson first decided to use "SEVENTEEN" as a trade name in October, 1944, over two months after promotion of plaintiff's magazine had commenced and one month after the appearance of the first issue (R. 560). Despite Hanson's active participation in the teen-age fashion field, he insisted that he had no prior knowledge of the existence of the magazine, of its purpose or its success in the teen-age field, and, of course, claimed that the magazine and its success had nothing to do with his choice of the name. He was forced to admit, however, on cross examination, that he had telephoned the editor of "SEVENTEEN" in late August, 1944, and had actually visited its editorial offices in New York City on September 6, 1944 (R. 641-645). He claimed that the purpose of his telephone call was to congratulate the editor, Mrs. Valentine, on having transferred from another magazine to Triangle Publications, Inc., although he had met her only once before, several years previously, and he insisted that there was no intimation of the existence of the magazine "SEVENTEEN" in this conversation (R. 642). As to his visit to the editorial offices on September 6th, he testified he did not see the name "SEVENTEEN" on the main entrance because the elevator let him off at the wrong floor and he came in through a back stairway in a large modern New York office building (R. 644). Persistent to the end, even after admitting that he was conducted to the reception desk in the lobby, he claimed not to have seen the large display, consisting of a five-foot blow up of the cover of the first issue of "SEVENTEEN" surrounded by congratulatory messages and telegrams, which even the most preoccupied individual could not possibly have missed (R. 645, 926-927).

Incidentally, Hanson also denied that he knew that his own firm was listed as "SEVENTEEN" in the St. Louis telephone directory (R. 627, 632, 959).

That Hanson debated the use of the trade-mark "SEVENTEEN" with full knowledge of the magazine as late

as October 29, 1944, is clear from a telegram sent by his attorney to another attorney on that date requesting a trade-mark search:

"INDIVIDUAL HERE ORGANIZED JUNIOR DRESS COMPANY NAMED SEVENTEEN DESIRES REGISTER MARK. SEARCH IF REGISTERED FOR DRESSES. NEW MAGAZINE USING SAME NAME, IS MARK REGISTERED. WOULD THIS CONFLICT WITH DRESS BUSINESS" (R. 637).

The eventual addition of the words "for the Junior Teens" was obviously an after thought and cover-up (R. 637-638). The lettering on defendants' letterheads, tags and labels gives all the prominence to the word "SEVENTEEN" (R. 958), and in defendants' first letter to the trade, dated January 15, 1945, the opening sentence read, "May I tell you the story of 'SEVENTEEN'" (R. 625). The evidence also showed that merchandisers advertising defendants' dresses emphasize the word "SEVENTEEN" and minimize the additional words "for the Junior Teens" which are frequently omitted (R. 203-211). Defendants made no effort to prevent this emphasis on the word "SEVENTEEN" (R. 959). Furthermore, defendants themselves furnished hang tags for their dresses which emphasized the name "SEVENTEEN", and thus promoted confusion with similar hang tags furnished by plaintiff, which we have already described (R. 959).

On December 1, 1944, defendants were informed that plaintiff would oppose their infringement of its trade-mark "SEVENTEEN". Defendants had made no actual use of the name until mid-November, 1944, and then only in connection with a display in New York City of a proposed line of dresses to be delivered in the Spring of 1945, which were actually not delivered until May, 1945 (R. 958). Defendants' first circular letter was sent to the trade on January 15, 1945 (R. 625), and their first advertisement appeared on May 19, 1945.

ARGUMENT.

I. Federal Jurisdiction Exists.

(a) THERE IS DIVERSITY OF CITIZENSHIP AND THE AMOUNT IN CONTROVERSY EXCEEDS \$3,000.

Defendants' own counsel, at the conclusion of the trial stated:

"May I correct one idea, Your Honor, as to the question of jurisdiction? There is no question of the Court's jurisdiction at all in this matter; the diversity of citizenship is sufficient" (R. 933).

Defendants' subsequent attack on jurisdiction may be viewed with some scepticism.

Plaintiff proved that it expended \$150,000 in initially promoting the name of its magazine, that the magazine attained an immediate and continued national preeminence, its monthly circulation growing rapidly from 380,000 to 750,000, and its advertising rates increasing from \$750 to \$1,200 and \$1,800 per page, that during the first few months of the magazine's existence over 100 manufacturers and merchandisers requested permission to use its name, and that the defendants had sold more than \$200,000 worth of dresses under the name "SEVENTEEN for the Junior Teens."

In actions for unfair competition in the use of trademarks and trade-names it has been repeatedly held that the test in determining the amount in controversy is not the immediate pecuniary damages arising from the wrongful acts. "It is the value of the business or the right to be protected; a business reputation or good-will is an intangible, to be taken into consideration in ascertaining the extent and value of the business or right." *Indian Territory Oil & Gas Co. v. Indian Territory I. Oil Co.*, 95 F. (2d) 711, 713 (C. C. A. 10th, 1938), cert. den., 305 U. S. 607 (1938); *Harvey v. American Coal Co.*, 50 F.

(2d) 832, 834 (C. C. A. 7th, 1931), cert. den., 284 U. S. 669 (1931); *Del Monte Special Food Co. v. California Packing Corp.*, 34 F. (2d) 774, 776 (C. C. A. 9th, 1929); *Beneficial Industrial Loan Corp. v. Kline*, 132 F. (2d) 520, 525 (C. C. A. 8th, 1943); *Coca-Cola Co. v. Snow Crest Beverages*, 162 F. (2d) 280, 281 (C. C. A. 1st, 1947). Here, the evidence goes even further by also showing defendants' receipts from the sale of their merchandise under the contested trade-mark. Neither of the two cases cited by defendants (*McNutt v. General Motors Accept. Corp.*, 298 U. S. 178, and *KVOS v. Associated Press*, 299 U. S. 269), involved the appropriation of a trade-mark or trade-name, and in both of these cases it is clear from the facts recited that there was serious doubt as to the extent of the threat presented to the rights involved. Neither of these two decisions indicate any intention to change the established rule with respect to unfair competition involving trade-marks and trade-names, nor were they deemed material in the *Indian Territory* case, *supra*, in which certiorari was denied, and in which, as in the *Harvey* case, *supra*, the question now raised by defendants was squarely presented.

(b) THE ACTION FOR UNFAIR COMPETITION WAS PEND-
 ENT TO AN ACTION FOR INFRINGEMENT OF A REGISTERED
 FEDERAL TRADE MARK, WHICH, WAS NOT "PLAINLY UN-
 SUBSTANTIAL".

The doctrine of *Hurn v. Oursler*, 289 U. S. 238 (1933), and *Armstrong Paint and Varnish Works v. Nu-Enamel Corp.*, 305 U. S. 315 (1938), applies squarely to the present case. The allegation and proof of trade-mark infringement was anything but unsubstantial. It was, in fact, sustained by the District Court (R. 949, 950-951, 960) and it was carefully discussed by the Circuit Court of Appeals (R. 1023-1024).

Defendants contend that since, under the ruling of the appellate court, plaintiff's magazine and defendants'

dresses were held not to fall within the meaning of that much-litigated phrase "merchandise of the same descriptive properties", the cause of action for infringement was plainly unsubstantial. Yet the modern cases have so greatly liberalized the meaning of that phrase that a substantial question was certainly presented as to whether this case falls within the expanded area of protection enunciated in those cases: *Del Monte Special Food Co. v. California Packing Corp.*, 34 F. (2d) 774 (C. C. A. 9th, 1929); *General Shoe Corp. v. Forst Chain Corp.*, 113 F. (2d) 127 (C. C. P. A., 1940); *California Fruit Growers Exchange v. Windsor Beverages*, 118 F. (2d) 149 (C. C. A. 7th, 1941); *Dwinnell-Wright Co. v. National Fruit Products Co.*, 140 F. (2d) 618 (C. C. A. 1st, 1944); see also *L. E. Waterman Co. v. Gordon*, 72 F. (2d) 272 (C. C. A. 2nd, 1934).

In cases involving widely divergent types of goods it has been held that the cause of action for trade-mark infringement is not plainly unsubstantial, and jurisdiction of the pendent cause of action for unfair competition has been sustained although the federal action failed: See *L. E. Waterman Co. v. Gordon*, *supra* (fountain pens and razor blades); *Bulova Watch Co. v. Stolzberg*, 69 Fed. Supp. 543 (D. Mass. 1947) (watches and shoes). Petitioners have cited no authority to the contrary.

II. The Question as to What Law Applies.

No substantial question of conflict of laws is here presented, since, as the Circuit Court of Appeals carefully pointed out (R. 1026), there is no difference between the several laws asserted to be applicable. Whether, as urged in *Bulova Watch Co. v. Stolzberg*, 69 Fed. Supp. 543 (D. Mass. 1947), the decisions of the federal courts should govern since jurisdiction is not founded on diversity alone, or whether the law of the forum (Missouri), or the law of the place where the

wrong was first inflicted (New York) should apply, there would be no difference in the result in this case. See *e. g.*, *Vogue Co. v. Thompson-Hudson Co.*, 300 Fed. 509 (C. C. A. 6th, 1924); *Yale Electric Corp. v. Robertson*, 26 F. (2d) 972 (C. C. A. 2d, 1928); *Adolph Kastor & Bros. Inc. v. Federal Trade Comm'n*, 138 F. (2d) 824 (C. C. A. 2d, 1943); *Atlas Diesel Engine Corp. v. Atlas Diesel School*, 60 F. Supp. 429 (E. D. Mo. 1945); *National Telephone Directory Co. v. Dawson Mfg. Co.*, 214 Mo. App. 683, 263 S. W. 483 (1924); *Thomas Patrick, Inc. v. K W K Investment Co.*, Sup. Ct. of Mo., decided December 8, 1947 (not yet reported); *Tiffany & Co. v. Tiffany Productions*, 147 Misc. 679, 264 N. Y. S. 459, *aff'd*, 262 N. Y. 482, 188 N. E. 30 (1933); *New York World's Fair 1939, Inc., v. World's Fair News, Inc.*, 297 N. Y. S. 923 (1937), *aff'd* 256 App. Div. 373, 10 N. Y. S. (2d) 56, *app. den.* 280 N. Y. 813 (1939); *Philadelphia Storage Battery Co. v. Mindlin*, 163 Misc. 52, 296 N. Y. S. 813 (1937).

The *lex loci delictus* was, of course, New York, where plaintiff's magazine is edited, where the nation's leading buyers and advertisers are located, and where defendants in November, 1944, made their first public commercial use of the name "SEVENTEEN" (R. 958). See *Restatement of the Conflict of Laws*, Sections 212, 337 (illustration No. 7).

III. The Missouri Law.

Only a few days before the filing of the present petition, the Supreme Court of Missouri handed down a decision clearly sustaining the holding of the District and Circuit Courts here that the Missouri law embraces the modern concept of unfair competition, and that under Missouri law it is not necessary to show that plaintiff and defendant are in direct competition or that defendant has attempted to palm off his goods as those of the

plaintiff. The decision, which has not as yet been reported, is in the case of *Thomas Patrick, Inc., v. K W K Investment Company, et al.*, No. 40,329, decided December 8, 1947. In that case plaintiffs, operators of a radio station titled "KWK" sued to enjoin defendants from operating a real estate and hotel business under the title "K. W. K. Investment Company". The defendants contended that since there was no passing off, no direct competition, no showing of actual deception or of damage to the plaintiff, the Court should apply the narrow technical rule of unfair competition and deny relief. The Court rejected this contention and stated the law to be as follows:

"As a preliminary it should be noted that it is not a necessary prerequisite to relief in cases of this nature that someone, in point of fact, has been deceived (*Liggett & Myers Tobacco Co. v. Sam. Reid Tobacco Co.*, 104 Mo. 53, 60, 15 S. W. 843, 844) or that the plaintiff, in point of fact, has sustained an actual loss of business, injury to good will or damages. *Standard Oil Co. of New Mexico v. Standard Oil Co. of California*, 56 F. (2) 973). It is no longer necessary that the parties be engaged in competitive businesses (*Vogue Co. v. Thompson-Hudson Co.*, 300 F. 509) or that an actual diversion of business be shown. *Great Atlantic & Pacific Tea Co. v. A. & P. Radio Stores*, 20 F. Supp. 703, 704. At least in some spheres of activity, nowadays, a plaintiff's trade name is entitled to protection against a subsequent user of the name if the designation complained of is so similar to the plaintiff's trade name that there is reasonable likelihood of confusion of source, such that prospective purchasers or clients are likely to regard the name as indicating the source identified by the name and consequently future injury to good will, reputation or business."

Furthermore, the decision of the Circuit Court of Appeals in our case was twice cited by the Missouri Court as one of the authorities for its holding, along with the *Vogue* and other federal cases. It is thus fantastic to assert that the Circuit Court's decision was out of line with the law of Missouri.

Defendants have merely cited various quotations from Missouri cases which are not at all analogous on the facts in an attempt to show that the Missouri law is otherwise. However, even prior to the *Thomas* case, it was evident that the Missouri courts had adopted the modern ruling of unfair competition, as the Circuit Court of Appeals carefully pointed out (R. 1026). See *National Telephone Directory Co. v. Dawson Mfg. Co.*, 214 Mo. App. 683, 263 S. W. 483, 484 (1924).

IV. Plaintiff is Entitled to Relief Under the Common Law of Unfair Competition.

In their fourth specification of error defendants raise several objections on the merits, assuming the general common law to be applicable. Each of these objections has been specifically considered and emphatically rejected in one or more decisions involving unfair competition in the use of trade-marks. These objections, together with a few of the cases refuting them, are as follows:

(a) That plaintiff has not proved palming off of defendants' products for plaintiff's:

Rejected in *Yale Electric Corporation v. Robertson*, 26 F. (2d) 972 (C. C. A. 2nd, 1928); *Vogue Co. v. Thompson-Hudson Co.*, 300 Fed. 509-512 (C. C. A. 6th, 1924); *Thomas Patrick, Inc. v. K W K Investment Company, et al., supra*.

(b) That plaintiff has not proven that it has suffered any liquidated pecuniary damage:

Rejected in *Philadelphia Storage Battery Co. v. Mindlin*, 296 N. Y. S. 176 (1937); *Churchill Downs Distilling Company v. Churchill Downs, Inc.*, 90 S. W. (2d) 1041 (Ky. 1936).

(c) That defendants' name is not identical to plaintiff's in that it includes additional words:

It is well settled that added words and their embellishment do not destroy property rights in a trade-mark, and that if the likelihood of confusion exists, the use of the infringing mark will be enjoined although it is not identical: *Saxlehner v. Eisner & Mendelson Co.*, 179 U. S. 19 (1900); *Vi-Jon Laboratories v. Lentheric*, 133 F. (2d) 947 (C. C. P. A. 1943); *Dorothy Gray Salons v. Mills Sales Co.*, 162 Misc. 789, 295 N. Y. S. 264 (1937).

(d) That plaintiff's fashion magazine is not in direct competition with defendants' dresses:

See cases cited *supra* in Section II of this brief: see also *Wall v. Rolls-Royce*, 4 F. (2d) 333 (C. C. A. 3rd, 1925); *Alfred Dunhill of London v. Dunhill Shirt Shop*, 3 Fed. Supp. 487 (S. D. N. Y., 1929); *Time, Inc. v. Barshay*, 27 F. Supp. 870 (S. D. N. Y., 1939); *Walter v. Ashton*, 2 Chancery Div. 282 (1902).

(e) That there had been some commercial use of the name prior to plaintiff's use:

It has already been pointed out in the Statement of the Case that the prior use of the name "SEVENTEEN" had never been extensive, had never related to the field of teen-age fashions or interests, and that the cosmetics firm which had made some use of the name ceased to advertise its product in 1937 and did not resume advertising until after the established success of "SEVENTEEN" magazine. It is well settled that proof of prior use is no defense unless the prior use was in a field which might

cause confusion with plaintiff's product and was sufficiently extensive to give the name a secondary meaning relating to the prior user within that field: *Ward Baking Co. v. Potter-Wrightington*, 298 Fed. 398, 401, 402 (C. C. A. 1st, 1924); *Del Monte Special Food Co. v. California Packing Corp.*, 34 F. (2d) 774 (C. C. A. 9th, 1929); *Jenney Mfg. Co. v. Leader Filling Stations*, 196 N. E. 852 (Mass., 1935); *Churchill Downs Distilling Co. v. Churchill Downs Inc.*, 90 S. W. 2nd 1041 (Ky. 1936).

(f) That defendants' decision to use the name was made only a few months after the initial promotion and appearance of plaintiff's magazine:

Defendants decided to use the name in mid-October, 1944, over two months after the opening of plaintiff's promotion campaign in August of that year. Defendants' first delivery of dresses was not made until May, 1945. The trial Court made an express finding that "'SEVENTEEN' as the title of plaintiff's magazine almost immediately acquired a secondary meaning entitling it to protection" (R. 961). Another District Court made the same finding in a parallel case in the Southern District of New York, *Triangle Publications, Inc. v. Rorhlich, et al.*, 73 Fed. Supp. 74 (1947). It is well settled that no particular period of time is required for the acquisition of secondary meaning entitling a trade-name to protection. Under modern conditions of publicity and promotion, such a meaning may be acquired virtually overnight: *Restatement of Torts*, Vol. 3, Sec. 716, Comment b; *Premier Pabst v. Elm City Brewing Co.*, 9 Fed. Supp. 754, 758 (D. C. Conn., 1935); *New York World's Fair 1939, Inc. v. World's Fair News, Inc.*, 297 N. Y. S. 923 (1937), App. den. 280 N. Y. 813 (1939); *Hemingway v. Film Alliance*, 21 N. Y. S. 2d 827 (1940).

All of the foregoing questions appear to be raised in defendants' fourth specification of error, and have

therefore been treated in the fourth section of this brief. Later sections of defendants' brief discuss again the same questions, and where this is the case, this brief will refer back to the appropriate subheading above.

V. "Seventeen" is a Valid Trade-mark and the District Court Correctly Found that the Name "Seventeen" as Used by Plaintiff Acquired a Secondary Meaning.

At the outset, it should be noted that the question of secondary meaning becomes material only where the trade-mark in suit is descriptive or otherwise invalid when first used by the plaintiff. Here, however, plaintiff's trade-mark "SEVENTEEN" was always valid and was so held by both the District and Circuit Courts, and was registered as such the United States Patent Office. Its validity is not questioned in the instant Petition.

The immediate fame and success of the magazine "SEVENTEEN" has been sufficiently discussed in the opening Statement, if secondary meaning be an issue here. We have already pointed out in subparagraph (f) of Section IV, *supra*, that secondary meaning can be acquired in a short space of time. It is also well settled that even descriptive words may acquire secondary meaning: *Photoplay Publishing Co. v. LaVerne Publishing Company*, 269 Fed. 730 (C. C. A. 3rd, 1921); and words of ordinary meaning used as titles of magazines have been given protection after acquiring secondary meaning: *Esquire, Inc. v. Esquire Bar*, 37 Fed. Supp. 875 (S. D. Fla., 1941); *Famous Funnies, Inc. v. Famous Funn Family*, 37 Fed. Supp. 903 (S. D. N. Y., 1941).

It should be pointed out that *Time, Inc. v. Viobin*, 128 Fed. (2d) 860 (C. C. A. 7th, 1942), did not hold that the name "TIME" could not obtain a secondary meaning, but merely that it had not done so in the field of cereal breakfast foods.

VI. The District Court's Finding that Defendants' Appropriation of the Trade-Mark was Deliberate and that It Constituted Unfair Competition.

Defendants seek to raise again in this Court the factual question of whether the trial court was correct in finding defendants guilty of deliberate appropriation of the name in an attempt to get a "free ride" on plaintiff's reputation. This finding was amply sustained by the evidence, as the Circuit Court of Appeals has already found, and is certainly no justification for the issuance of a writ of certiorari.

In cases of this nature, proof of likelihood of confusion is of itself sufficient for the granting of relief, and this is particularly so where the appropriation by defendant is deliberate and wanton. See *L. E. Waterman Co. v. Gordon*, 72 F. (2d) 272 (C. C. A. 2nd, 1934); *Tiffany & Co. v. Tiffany Products*, 147 Misc. 679, 264 N. Y. S. 459, aff'd 262 N. Y. 482, 188 N. E. 30 (1933).

VII. The Injunction Granted is no Broader Than the Facts Require and Does Not Constitute an Abuse of Discretion.

Defendants argue that an absolute injunction is unjustified. In the cases relied upon, however, it appears that the infringement arose solely out of the particular manner in which the name was misused. But where every use made by defendant tends to cause confusion of the public and violates plaintiff's rights, an absolute injunction is proper: *Del Monte Special Food Co. v. California Packing Corp.*, 34 F. (2d) 774, 777 (C. C. A. 9th, 1929).

Such injunctions have been repeatedly issued: *e. g.*, *L. E. Waterman Co. v. Gordon*, 72 F. (2d) 272 (C. C. A. 2d, 1934); *Yale Electric Corp. v. Robertson*, 26 F. (2d) 972 (C. C. A. 2d, 1928); *Wall v. Rolls-Royce of America*, 4 F. (2d) 333 (C. C. A. 3d, 1925); *Bulova Watch Co. v. Stolzberg*, 69 F. Supp. 543 (D. Mass., 1947).

Under the facts found, the form of the injunction was not only within the discretion of the Court, but was required.

VIII. Plaintiff is Entitled to Protection of the Economic Value of Its Name Within the Field in Which It Has Acquired a Secondary Meaning.

Plaintiff brought this action in the protection of an economic value which it alone created. This value consists in the unparalleled prestige and influence which the name "SEVENTEEN" has come to have in a very limited and highly specialized field, the field of teen-age fashions. The extent of this prestige is impressive, and it is an important element in plaintiff's case.

The remarkable degree to which plaintiff's trade-mark captured its public came about (a) because plaintiff's was the first magazine to devote itself on an intelligent plane exclusively to the interests of high school girls, (b) because plaintiff expended large sums in highly effective promotion, and (c) because the excellence of plaintiff's product almost overnight won for it a following among teen-agers, their parents, their teachers and girls' organizations, that is not even approached by any other magazine.

A major part of the record in this case is devoted to the unfolding of the story of the growth of "SEVENTEEN's" prestige, in legal terminology, the acquisition of a secondary meaning by the trade-mark "SEVENTEEN".

Defendants contend that plaintiff claims the exclusive right to the use of the word "SEVENTEEN" as a trade-mark for any merchandise that may be advertised in its magazine. That is absolutely incorrect. The plaintiff has never made and does not now make any such contention. It merely claims the right to enjoin the use of the trade-mark "SEVENTEEN" upon teen-age apparel. It is in the teen-age fashion and apparel field that the economic value of the name "SEVENTEEN" has come to mean so

much; and this is the very field in which defendants have attempted to obtain a "free ride" on the prestige of plaintiff's magazine by the simple device of appropriating its name to sell to its readers the very product to which the fashion magazine is devoted.

There is nothing new or revolutionary about the protection here invoked, as is shown by the following quotation from the leading case on the subject, decided almost twenty-five years ago:

"* * * there is no fetish in the word competition. The invocation of equity rests more vitally upon the unfairness. * * * In this case the reasonable probability of injury to plaintiff through defendant's misrepresentation is clear, even if it has not actually occurred. Plaintiff's magazine is so far an arbiter of style, and the use of plaintiff's trademark upon defendant's hats so far indicates that the hats were at least sponsored and approved by the plaintiff, that the same considerations which make the misrepresentation so valuable to defendant make it pregnant with peril to plaintiff." *Vogue Co. v. Thompson-Hudson Co.*, 300 Fed. 509, 512 (C. C. A. 6th, 1924).

CONCLUSION.

For the foregoing reasons plaintiff respectfully submits that the defendants' petition for a writ of certiorari to the Circuit Court of Appeals for the Eighth Circuit should be denied.

Respectfully submitted,

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